REMARKS

The Office Action of April 27, 2007 was received and carefully reviewed. Reconsideration and withdrawal of the currently pending rejections are requested for the reasons advanced in detail below.

The Examiner mentions that claims 1, 8-10, 12, 13, 19, 21, 23, 24, 30-37, 44, 46, 48, 49, 55, 57, 59, 60, and 66-70 are pending. However, claim 9 has been canceled and claims 71 and 72 are still pending. In accordance with the interview summary of December 29, 2003, claims 2-7, 9, 11, 14-18, 20, 22, 25-29, 38-43, 45, and 47 are added as new claims 73-100 respectively. Consequently, claims 1, 8-10, 12, 13, 19, 21, 23, 24, 30-37, 44, 46, 48, 49, 55, 57, 59, 60, 66-70, and 71-100 are currently pending in the instant application.

Claims 1, 10, 12, 13, 37, 46, and 48-49 were rejected under 35 U.S.C. §102(e) as being anticipated by Chae (U.S. 5,432,122). Chae, however, fails to render the claimed invention unpatentable. Each of the claims recite a specific combination of features that distinguishes the invention from the prior art in different ways. For example, independent claims 1 recites a combination that includes, among other things:

> wherein said scan direction is parallel to said channel region,

Independent claims 10 and 46 recite similar features. At the very least, Chae fails to disclose or suggest any of these exemplary features recited in the independent claims 1, 10 and 46.

Turning to the prior art, Chae, as previously admitted by the Patent Office in at least the Office Actions mailed on May 24, 2002 and November 30, 2001, fails to teach the scanning direction of the laser beam as parallel to the channel direction as recited by Applicants' claims. However, the Examiner now contends that Chae discloses the scanning

direction is parallel to the channel region. However, upon further review of Chae, the reference discloses that the gate (22) extends along the scanning direction (e.g., see FIG. 7). The scanning direction of Chae is **not** (emphasis added) parallel but perpendicular to the channel direction. Thus, Chae clearly teaches away from the invention as claimed.

For anticipation under 35 U.S.C. § 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present (M.P.E.P. 706.02). Since each and every element, as set forth in the claims are not found either expressly or inherently described as required by the M.P.E.P., Chae cannot be said to anticipate the invention as claimed. Hence, withdrawal of the rejection is respectfully requested.

Each of the dependent claims depend from one of independent claims 1, 10 or 46 and are patentable over the cited prior art for at least the same reasons as set forth above with respect to claims 1, 10 or 46.

In addition, each of the dependent claims also recite combinations that are separately patentable.

Claims 8, 18, 44, and 55 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Chae in view of Imahashi et al. (US 5,413,958). Claims 21, 23, 24, 57, 59, and 60 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Chae in view of Weiner et al. (US 5,413,958). Claims 30 and 66 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Chae and Weiner et al. in view of Imahashi et al. Chae, Imahashi et al., and Weiner et al., however, fail to render the claimed invention unpatentable. Each of the claims recites a specific combination of features that distinguishes the invention from the prior art in different ways. Again, Chae, the base reference fails to disclose or fairly suggest the scan direction being parallel to the channel region as outlined above. Thus, any depending claims which rely on this feature are also not disclosed by Chae. At the very least,

the applied references, whether taken alone or in combination, fail to disclose or suggest any of these exemplary features recited by the claims of the instant invention.

The Examiner has failed to establish a *prima facie* case of obviousness for at least four reasons. First, the Examiner has not demonstrated how Chae, Imahashi et al., and Weiner et al., whether taken alone or in combination, disclose or suggest each and every feature recited in the claims. *See* M.P.E.P. § 2143 (7th ed. 1998). Second, the Examiner has not shown the existence of any reasonable probability of success in modifying Chae, the base reference, based on the teachings of Imahashi et al. and Weiner et al., the secondary references, in a manner that could somehow result in the claimed invention. *See id.* Third, the Examiner has not identified any suggestion or motivation, either in the teachings of the applied references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the apparatus of Chae in a manner that could somehow result in the claimed invention. *See id.* Finally, the Examiner has not explained how his obviousness rationale could be found in the prior art — rather than being a hindsight reconstruction of Applicants' own disclosure. *See id.*

Each of the Examiner's factual conclusions must be supported by "substantial evidence" in the documentary record, as required by the Federal Circuit. *See In re Lee*, 61 U.S.P.Q.2d 1430, 1435 (Fed. Cir. 2002). The Examiner has the burden of documenting all findings of fact necessary to support a conclusion of anticipation or obviousness "less the 'haze of so-called expertise' acquire insulation from accountability." *Id.* To satisfy this burden, the Examiner must specifically identify where support is found within the prior art to meet the requirements of 35 U.S.C. §§ 102(b) and 103. In this case, however, the Examiner has failed to satisfy his burden of demonstrating how Chae, taken alone or in combination with Imahashi et al. and Weiner et al., can either anticipate or render obvious each and every

one of the limitations present in the independent claims as required by the MPEP and Federal Circuit jurisprudence.

Imahashi et al. and Weiner et al. do not cure the deficiencies of Chae. There is simply no disclosure of the scan direction being parallel to the channel region as recited by the claims.

In accordance with the M.P.E.P. § 2143.03, to establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 196 (CCPA 1970). Therefore, it is respectfully submitted that neither Chae, Imahashi et al. nor Weiner et al., taken alone or in any proper combination, discloses or suggests the subject matter as recited in by the claims. Hence, withdrawal of the rejection is respectfully requested.

In addition, each of the dependent claims also recite combinations that are separately patentable.

In view of the foregoing remarks, this claimed invention, as amended, is not rendered obvious in view of the prior art references cited against this application. Applicant therefore request the entry of this response, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

In discussing the specification, claims, and drawings in this response, it is to be understood that Applicant in no way intends to limit the scope of the claims to any exemplary embodiments described in the specification and/or shown in the drawings. Rather, Applicant is entitled to have the claims interpreted broadly, to the maximum extent permitted by statue, regulation, and applicable case law.

Should the Examiner believe that a telephone conference would expedite issuance of the application, the Examiner is respectfully invited to telephone the undersigned patent agent at (202) 585-8316.

Respectfully submitted,

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